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10/501,026	07/09/2004	Robert D. Coleman	7255-5	3624

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EXAMINER	
CHUI, MEI PING	

ART UNIT	PAPER NUMBER
1616	

MAIL DATE	DELIVERY MODE
09/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/501,026

Applicant(s)

COLEMAN, ROBERT D.

Examiner

Helen Mei-Ping Chui

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 7-9, 13, 14 and 26-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 10-12 and 15-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 09/20/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Status of Action

Applicant's election without traverse of invention I, which encompasses claims 1-25 in the reply filed on 08/09/2007 is acknowledged. In response to the election of species requirement, applicant elected glycolic acid as the species of organic carboxylic acid for examination in this reply.

The requirement is still deemed proper and is therefore made FINAL.

Status of Claims

Accordingly, claims 1-6, 10-12, 15-25 are presented for examination on the merits for patentability as they read upon the elected subject matter and claims 7-9, 13-14 and 26-32 directed to non-elected inventions and species are withdrawn.

It is noted that in claim 1 the term "lysineand" in line 13 should be separated by a space. In claim 19 the term "of" in line 2 should be written as "or". Applicant is required to correct the typographical errors.

DOUBLE PATENTING

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1, 3-6, 10-12 and 15-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-3, 5-7 and 11-20 of co-pending U.S. Patent Application No. 11/767,829. The instant claims 1, 3-6, 10-12 and 15-20 are drawn to a fungicide composition comprising a fatty acid having 5 to 22 carbon atoms, an organic carboxylic acid, a carrier as recited in the claims, where the claims 1-3, 5-7 and 11-20 of co-pending U.S. Patent Application No. 11/767,829 are directed to a composition comprising a fatty acid having 5 to 22 carbon atoms, an organic carboxylic acid, a diluent, and an emulsifier as recited in the claims. The instant and conflicting claims are only differed by an additional emulsifier recites in the conflicting claims. It is noted that the dependent claim 18 of the instant application recites the carrier is water, kerosene, xylene, mineral oil, vegetable, seed oil or alcohol and a mixture thereof, and the dependent claim 18 of the conflicting co-pending application recites the diluent is water, kerosene, xylene, mineral oil, vegetable, seed oil or alcohol and a mixture thereof. Therefore, one of ordinary skill in the art, at the time the claimed invention was made, would have readily recognized that claims 1-3, 5-7 and 11-20 found in co-pending U.S. Patent Application No. 11/767,829 and claims 1, 3-6, 10-12 and 15-20 in the instant application are obvious variant and are not patentability distinct to each other.

Claim Rejections - 35 USC § 112 second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 19, recites the phrase "i.e." rendering the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 5 recites the limitation "caprylic acid or pelargonic acid" depends from independent claim 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejection - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102(b) that form the basis for the rejections under this section made in this Office action:

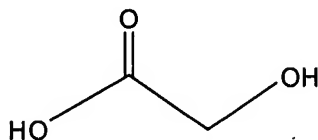
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 6, 10-12, 15-20 and 23-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Herdt et al. (U. S. Patent No. 5,998,358).

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With respect to claims 1, 4, 6, 15-16, 19-20 and 25, Herdt et al. disclose a composition comprising hydroxyl carboxylic acid (column 2, line 42-43), preferably glycolic acid (also known as hydroxyacetic acid) (column 3, line 22 and 28), alcohol or water (column 2, line 44 and column 3, line 1-2), and short chain fatty acid (column 11, line 5). The structure of glycolic acid (see below) contains a straight chain alkyl group with a hydroxyl substituent and a carboxylic acid functionality as follows:



Therefore, claims 1, 4, 6, 15-16, 19-20 and 25 are anticipated.

With respect to claims 11 and 12, Herdt et al. specifically disclose that the weight percentage of the fatty acid and the glycolic acid in the composition is 1 % and 5 % respectively (column 14-16, Tables 1-3 for C10 FA and hydroxyacetic acid), which corresponds to the weight ratio of 1:5. Therefore, claims 11 and 12 are anticipated.

With respect to claims 17 and 18, Herdt et al. disclose that a composition comprising a lower alkanol or a major proportion of water (column 2, line 43-44 and column 3, line 1-2), which is used as liquid carrier, solvent or as diluent. Therefore, claims 17 and 18 are anticipated.

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With respect to claims 10 and 23-24, Herdt et al. disclose that the weight % of glycolic acid relative to the total weight of the composition is 5% (column 14-16, Tables 1-3 for hydroxyacetic acid), which corresponds to about 0.39 % volume based on the density of glycolic acid is 1.27 g/mL. Therefore, claims 10 and 23-24 are anticipated.

With respect to the art rejection set forth above, it is noted that the reference of Herdt et al. do not disclose that the composition can be used in the manner instantly claimed in claims 19, 20 and 25; however, the intended use of the claimed composition does not patentably distinguish the composition, per se, since such undisclosed use is inherent in the reference composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting.

Notes to the Applicant

It is noted to the Applicant that instant claim 5 recites the composition of claim 1 comprising caprylic acid or pelargonic acid. Due to the aforementioned rejection of claim 5 under 35 U.S.C. 112, second paragraph for insufficient antecedent basis, for examination purposes, the Examiner interprets caprylic acid or pelargonic acid recites in claim 5 as a fatty acid component in the composition of claim 1 for the following rejections.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2-3, 5 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herdt et al. (U. S. Patent No. 5,998,358) in view of Puritch et al. (U. S. Patent No. 5,106,410).

Applicant Claims

Applicants claim a fungicidal composition comprising an organic carboxylic acid, a fatty acid and a carrier, wherein said fatty acid includes pelargonic acid, undecanoic acid, lauric acid or caprylic acid.

Determination of the scope and content of the prior art (MPEP 2141.01)

Herdt et al. teach a composition comprising hydroxyl carboxylic acid (column 2, line 42-43), preferably glycolic acid or also known as hydroxyacetic acid (column 3, line 22 and 28), alcohol or water (column 2, line 44 and column 3, line 1-2), and short chain fatty acid (column 11, line 5). The structure of glycolic acid contains a straight chain alkyl group with a hydroxyl substituent and a carboxylic acid functionality

Herdt et al. specifically teach that the weight percentage of the fatty acid and the glycolic acid in the composition is 1 % and 5 % respectively (column 14-16, Tables 1-3 for C₁₀ FA and hydroxyacetic acid), which corresponds to the weight ratio of 1:5.

Herdt et al. also teach that the composition comprises a lower alkanol or a major proportion of water (column 2, line 43-44 and column 3, line 1-2), which can be used as liquid carrier, solvent or as diluent.

Herdt et al. further teach that the weight % of glycolic acid relative to the total weight of the composition is 5% (column 14-16, Tables 1-3 for hydroxyacetic acid), which corresponds to about 0.39 % volume based on the density of glycolic acid is 1.27 g/mL.

Puritch et al. teach a herbicidal or fungicidal composition comprises a ready-to-use microemulsion having a fatty acid active ingredient and water (Abstract, line 1-4 and 6; column 1, line 13-14).

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Puritch et al. teach a fatty acid component of the composition having a hydrocarbon chain with between 8 and 12 carbon atoms including caprylic acid, undecanoic acid and lauric acid, preferably pelargonic acid (Abstract, line 17-18; column 2, line 6-10).

Ascertainment of the difference between the prior art and the claims
(MPEP 2141.02)

Herd et al. do not explicitly teach a specific fatty acid and the % volume of said fatty acid comprising in the composition.

Finding of prima facie obviousness Rational and Motivation
(MPEP 2142-2143)

It would have been obvious to a person of ordinary skilled in the art at the time the invention was made to combine the teachings of Herd et al. and Puritch et al. and utilize the claimed fatty acid and glycolic acid in aqueous media to obtain the instantly claimed fungicidal composition. It would have been obvious to a person of ordinary skilled in the art to use different volumes of the fatty acid in said composition based on the density of the specific fatty acid that is being used.

One of ordinary skill would have been motivated to utilize an organic carboxylic acid, i.e. glycolic acid in aqueous media, to produce an acidic composition that has anti-microbial effect and, in addition, to include a fatty acid in the acidic composition to reduce foaming, with a reasonable expectation of success because fatty acid is an environmentally compatible ingredient

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and can be used as an anti-foaming agent in a ready-to-use formulation, as suggested by Herdt et al. and Puritch et al.

Therefore, the claimed invention, as a whole, would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, because the combined teachings of the prior art fairly suggests the instant claims.

Conclusion

No claims are allowed.

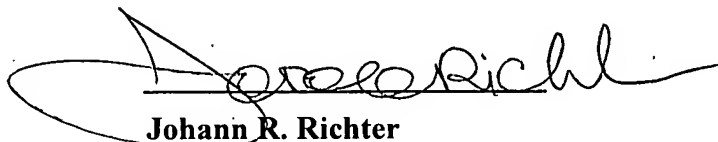
Contact Information

Any inquiry concerning this communication from the Examiner should direct to Helen Mei-Ping Chui whose telephone number is 571-272-9078. The examiner can normally be reached on Monday-Thursday (7:30 am – 5:00 pm). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either PRIVATE PAIR or PUBLIC PAIR. Status information for

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unpublished applications is available through PRIVATE PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the PRIVATE PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Johann R. Richter", is written over a horizontal line.

Johann R. Richter

Supervisory Patent Examiner

Technology Center 1600